

## REMARKS/ARGUMENTS

### *Amendments Generally*

Claims 1 through 83 have been canceled and new claims 84 through 108 have been added.

New claim 84 corresponds to original claims 30 and 31.

New claims 85 to 92 correspond to original claims 32 to 39.

New claim 93 corresponds to original claim 52.

New claims 94 to 100 correspond to original claims 54 to 60.

New claim 101 corresponds to original claim 62.

New claim 102 to 104 correspond to original claims 67 to 69.

New claim 105 corresponds to original claim 71.

New claim 106 is supported by the original description of the application as filed. (See *Specification* ¶ [0026]).

New claim 107 corresponds to original claim 74.

New claim 108 corresponds to original claim 82.

### *Traverse*

Applicant hereby traverses the Examiner's restriction requirement.

The Examiner considered that the application contains claims directed to two patentably distinct species: (1) Species of Figs. 1–3 and (2) Species of Figs. 8–10. The Examiner alleges that none of the claims are generic to all disclosed embodiments. We disagree with the

Examiner, particularly in light of the amendments to the claims. Specifically, new claim 84 is generic to both species.

Figs. 1–3 and Figs. 8–10 represent alternative embodiments of a directional drilling apparatus, both of which fall within the scope of new claim 84. To demonstrate this, new claim 84 is repeated below with the corresponding features of each embodiment identified.

**Regarding the Embodiment of Figs. 1–3**

The embodiment depicted in Figs. 1–3 falls within the scope of new claim 84 as shown:

84. A drilling apparatus (10) for drilling a deviated bore, said apparatus (10) comprising:
- a tubular outer member (12) having gripping means (grippers 20) for selectively engaging the wall of a bore to restrain the member (12) against rotation and including an offset portion (bent sub 22 which defines an offset, see *Specification* ¶ [0039]) for rotatably supporting a drill bit (24: rotatably supported by bearing 26);
  - an inner member (32) located within the outer member (12) and for coupling to the drill bit (24: coupled to the drill bit 24 via drive rod 28) at one end and to a drill string at another end;
  - wherein the apparatus (10) has a first configuration (as shown in Fig. 1) in which the gripping means (20) is retracted and the inner member (32) is coupled to the outer member (12) such that rotation of the drill string provides for corresponding rotation of the inner and outer members (32, 12: see *Specification* ¶ [0039]), and a second configuration (Fig. 2) in which the gripping means (20) is extended and the inner member (32) is rotatable relative to the outer member (12) such that the outer member (12) is

restrained from rotation in the bore and rotation of the drill string provides for corresponding rotation of the inner member (32) and the drill bit (24: see *Specification* ¶ [0041]),

and wherein the inner member (32) is moveable in at least one of an axial and rotatable direction relative to the outer member (12) to reconfigure the apparatus (10: inner member 32 is moved axially relative to the outer member 12 to engage the track 16 to effect reconfiguration).

Accordingly, the embodiment shown in Figs. 1–3 falls within the scope of new claim 84.

**Regarding the Embodiment of Figs. 8–10**

As with the embodiment depicted in Figs. 1–3, the embodiment depicted in Figs. 8–10 also falls within the scope of new claim 84 as shown:

84. A drilling apparatus (100) for drilling a deviated bore, said apparatus (100) comprising:
- a tubular outer member (112) having gripping means (120) for selectively engaging the wall of a bore to restrain the member (112) against rotation and including an offset portion (150) for rotatably supporting a drill bit (124: rotatably supported by bearing 126);
  - an inner member (132) located within the outer member (112) and for coupling to the drill bit (124: coupled to the drill bit 124 via drive rod 128) at one end and to a drill string at another end;

wherein the apparatus (100) has a first configuration (as shown in Fig. 8) in which the gripping means (120) is retracted and the inner member (132) is coupled to the outer member (112) such that rotation of the drill string provides for corresponding rotation of the inner and outer members (132, 112: see *Specification* ¶ [0058]), and a second configuration (shown in Fig. 9) in which the gripping means (120) is extended and the inner member (132) is rotatable relative to the outer member (112) such that the outer member (112) is restrained from rotation in the bore and rotation of the drill string provides for corresponding rotation of the inner member (132) and the drill bit (124: see *Specification* ¶¶ [0058]–[0060]),

and wherein the inner member (132) is moveable in at least one of an axial and rotatable direction relative to the outer member (112) to reconfigure the apparatus (100: the inner member 132 is moved axially relative to the outer member 112 to cause rotation of the offset portion 150 via pins 164 and helical tracks 166).

Accordingly, the embodiment shown in Figs. 8–10 falls within the scope of new claim 84.

#### ***Election With Traverse***

While the Applicant believes that the above argument traverses the restriction requirement, the Applicant, in complying with requirements for election, hereby elects, with traverse, examination of species (2), i.e., Species of Figs. 8-10. New claims, i.e., claims 84 through 108, are directed to this species.


***Conclusion***

None of the amendments made herein add new matter.

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED: This 20<sup>th</sup> day of July, 2007.

  
\_\_\_\_\_  
FRANK J. DYKAS  
Registration No. 28,072  
Telephone: (208) 345-1122

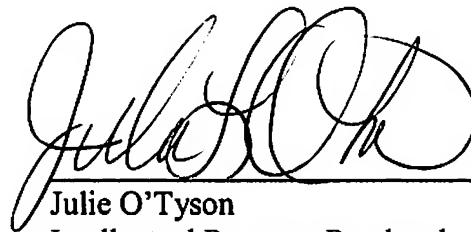
Examiner Tsay  
Serial # 10/516,439

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being electronically deposited with the United States Patent Office via the EFS-Web on the below date as addressed to:

Mail Stop Amendment  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

DATE: 7/20/07

A handwritten signature in black ink, appearing to read "Julie O'Tyson", is written over a horizontal line.

Julie O'Tyson  
Intellectual Property Paralegal